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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,291

04/05/2006

Edward J. Cheal

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07/16/2007

FOLEY HOAG, LLP

PATENT GROUP, WORLD TRADE CENTER WEST

155 SEAPORT BLVD

BOSTON, MA 02110

EXAMINER

SCHILLINGER, ANN M

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

07/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,291

Applicant(s)

CHEAL ET AL.

Examiner

Ann Schillinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/5/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities: misspelled word “transervse” in line 14. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 8, 9, 17-19, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by White et al. (US Pat. No. 5,902,340). White et al. discloses the following of claim 1: a joint prosthesis comprising: a head member (112) so sized and shaped as to be articulatable with a joint socket, the head member defining a head bore (see bore in Figures 1, 2); a proximal body member (110) that includes: a base (block between 111 and 411); a plug (111) protruding from the base and so sized and shaped as to be receivable in the head bore; and a spigot (412) protruding from the base, the spigot including a locking band (411) whose cross-sectional geometry is uniform transverse to the spigot's axis; and a stem member (120, 130) that includes: a proximal portion (top of 120) defining a stem bore (123) that: is sized and shaped for receiving the spigot; and includes a receiving portion whose cross-sectional geometry is uniform transervse

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to the bore's axis and is sized smaller than that of the locking band for engaging the locking band of the spigot by friction-tight press-fit as the proximal body member becomes fully seated on the stem member (col. 11, lines 19-25); and a shaft (bottom of 120, 130) extending from the proximal portion, being sized and shaped for seating in a cavity of a long bone, and including a midshaft portion (lower area of 120, middle of 130) and a distal portion (bottom of 130) of the stem member, at least a portion of the midshaft and/or the distal portion so tapered that the cross-sectional area of the shaft in that portion continuously decreases from its proximal end to its distal end (see Figure 4).

White et al. discloses claims 2, 8, and 9 as shown in Figure 4.

White et al. discloses the following of claim 17: the joint prosthesis of claim 1, wherein the proximal body member defines a hole (115) that passes through the spigot.

White et al. discloses the following of claim 18: the joint prosthesis of claim 17, wherein the stem member defines a hole (122, 134) at the base of the bore.

White et al. discloses the limitations of claims 19, 21, and 22 where the threaded hole is 134 and the bolt is 140.

White et al. discloses claim 20 as shown in Figure 1.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Dwyer et al. (US Pat. No. 6,706,072). Dwyer et al. discloses the following of claim 1: a joint prosthesis comprising: a head member (16) so sized and shaped as to be articulatable with a joint socket, the head member defining a head bore (see bore in Figures 1); a proximal body member (12) that includes: a base (24); a plug (26) protruding from the base and so sized and shaped as to be

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receivable in the head bore; and a spigot (34) protruding from the base, the spigot including a locking band (30, 32) whose cross-sectional geometry is uniform transverse to the spigot's axis; and a stem member (14, 18) that includes: a proximal portion (top of 14) defining a stem bore (36) that: is sized and shaped for receiving the spigot; and includes a receiving portion whose cross-sectional geometry is uniform transverse to the bore's axis and is sized smaller than that of the locking band for engaging the locking band of the spigot by friction-tight press-fit as the proximal body member becomes fully seated on the stem member (col. 7, lines 18-27); and a shaft (bottom of 14, 18) extending from the proximal portion, being sized and shaped for seating in a cavity of a long bone, and including a midshaft portion (lower area of 14, middle of 18) and a distal portion (bottom of 18) of the stem member, at least a portion of the midshaft and/or the distal portion so tapered that the cross-sectional area of the shaft in that portion continuously decreases from its proximal end to its distal end (see Figure 1).

Dwyer et al. discloses the limitations of claim 2, 8, and 9 as shown in Figure 1.

Dwyer et al. discloses the limitations of claims 3-7 in elements 30 and 32.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. or Dwyer et al. in view of DeMane et al. (US Pat. No. 5,507,830). White et al. and Dwyer et al. disclose the invention substantially as claimed, however, they probably do not disclose a stem

tapered in both the medial-lateral and the anterior-posterior directions. DeMane et al. teaches a stem tapered in both the medial-lateral and the anterior-posterior directions in Figure 5, and col. 3, lines 20-60 for the purpose of sealing wear particles from body tissues. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a stem tapered in both the medial-lateral and the anterior-posterior directions in order to sealing wear particles from body tissues.

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. or Dwyer et al. in view of Doubler et al. (US Pat. No. 6,299,648). White et al. and Dwyer et al. disclose the invention substantially as claimed, however, they probably do not disclose protruding keys and their respective receptacles. Doubler et al. teaches protruding keys and their respective receptacles in Figures 1, 3, and 4, and col. 4, lines 1-23 for the purpose of acting as a load-bearing element. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have protruding keys and their respective receptacles in order to act as a load-bearing element.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Schillinger whose telephone number is (571) 272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Schillinger
July 5, 2007


ALVIN J. STEWART
PRIMARY EXAMINER